

REMARKS

The last Office Action of September 17, 2009 has been carefully considered. Reconsideration of the instant application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 1-2, 4, 8, 11-16, 38, 45-46 are pending in the application. Claims 2, 11-13, 38, 46 have been amended. No claims have been canceled or added. No amendment to the specification has been made. No fee is due.

CLAIM REJECTIONS - 35 U.S.C. §112

Claims 2, 4, 11-13, 38 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant has amended claims 2, 11-13, 38 to address the §112 rejection. These changes are self-explanatory and cosmetic in nature and should not be considered as a narrowing amendment to trigger prosecution history estoppel.

Withdrawal of the rejection under 35 U.S.C. §112, second paragraph is thus respectfully requested.

CLAIM REJECTIONS - 35 U.S.C. §103

Claims 1-2, 4, 8, 11-14, 38, 45-46 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,809,833 to Newport et al. in view of U.S. Pat. No. 6,772,653 to Franksson.

Claims 15, 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Newport et al. and Franksson in view of FR 2632460 to Mounier.

The rejection under 35 U.S.C. 103(a) is respectfully traversed in view of the following remarks.

The Examiner has rejected the sole independent claim 1 as unpatentable over Newport et al. in view of Franksson, and submits that the disclosure of internal and external threads in Franksson can be used to modify Newport et al. in such a way that the housing (11, 12) can be threadably connected to the motor casing, on one hand, and to the attachment element (80), on the other hand.

Applicant respectfully disagrees with the Examiner's rejection of claim 1 and submits that the combination of Newport et al. and Franksson, as suggested by the Examiner fails to raise a *prima facie* case of obviousness.

Newport et al. describes a linear actuator including a hollow housing 11 for protectively enclosing most of the components thereof to prevent the entry of dirt, water, and other contaminants from the environment (col. 2, ll 36-39). In other words, the housing is intended to fully enclose the d.c. motor and the motor casing and there is no teaching or suggestion to establish a threaded engagement between the housing and the motor casing. The same applies to the connection between the housing and the attachment element 80.

It is well established that obviousness requires a suggestion of all the elements in a claim and a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in a way the claimed new invention does. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 [82 USPQ2d 1385] (2007). In the case at hand, the Examiner provided no reason that would have prompted the skilled worker to have arranged the claim elements in the manner necessary to reach the claimed invention. *Ex Parte Alexander*, 86 USPQ2d, 1120, 1122, U.SPTO Board of Patent Appeals and Interferences (2007). The fact that individual elements of the present invention can be found in the prior art is not determinative as to the question of obviousness.

In addition, applicant maintains the position that the Examiner's rejection allows applicant only to speculate as to the portions of the Franksson reference relied upon and why this reference contain a teaching, suggestion, reason, motivation or incentive leading to the claimed invention. Simply asserting that "*Franksson teaches the use of using internal and external threads to connect the housing and the*

attachment element", without indication to applicant which specific portions of the Franksson reference the Examiner refers to base her rejection on, does not comply with the practice set forth in §706.02(j) of the Manual of Patent Examining Procedure.

In any event, the disclosure of Newport et al. will not prompt an artisan to look at a reference which may describe the provision of threaded connections between components and combine it with Newport et al. to produce the present invention because the Newport et al. disclosure, in fact, teaches away from such a modification. MPEP § 2143.03(VI) states that "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." Accordingly, where cited art teaches away from a claimed feature, as is the situation at hand, the cited art is not available for the purposes of an obviousness rejection.

It is therefore respectfully submitted that the rejections under 35 U.S.C. §103(a) is improper and respectfully requests that the rejection of independent claim 1 be withdrawn.

As for the rejection of the retained dependent claims, these claims depend on claim 1, share its presumably allowable features, and therefore it is respectfully submitted that these claims should also be allowed.

Claim 46 has been amended to set forth the particular configuration of the attachment element in the form of a fork head. Support therefore can be found in paragraph [0059] of the instant specification. Claim 46 is further considered allowable on its own merits as the formation of the attachment element in the form of a fork head and the configuration of the fork head, as claimed, are neither taught nor suggested by the applied prior art.

Withdrawal of the rejection under 35 U.S.C. §103(a) is thus respectfully requested.

CONCLUSION

In view of the above presented remarks and amendments, it is respectfully

submitted that all claims on file should be considered patentably differentiated over the art and should be allowed.

Reconsideration and allowance of the present application are respectfully requested.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be helpful in advancing this case by calling the undersigned, applicant would greatly appreciate such a telephone interview.

Respectfully submitted,

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